



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,385	01/22/2002	Alexandre Rado	1006-02	5902

35811 7590 11/21/2003

IP DEPARTMENT OF PIPER RUDNICK LLP
3400 TWO LOGAN SQUARE
18TH AND ARCH STREETS
PHILADELPHIA, PA 19103

EXAMINER

WORLOH, JALATEE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,385

Applicant(s)

RADO, ALEXANDRE

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Response to Amendment

2. This Office Action is responsive to the amendment filed on September 17, 2003.

Response to Arguments

3. Applicant's arguments filed September 17, 2003 have been fully considered but they are not persuasive.

Applicant argues, "Ittah fails to disclose or suggest a payment card whose monetary amount can be selected by the user through the removal of a mask layer".

However, the examiner disagrees. Notice, Ittah discloses a payment card (2) with the highest monetary amount of 40 francs and numerous sub-totals comprising associated boxes. Each sub-total is of monetary value, "whose sum constitutes the total amount (1)". The sub-totals are associated with boxes that conceal a code number that must be starched prior to the card usage therefore, enabling "the selected monetary amount". Further, in a payment transaction, "the sub-total and the associated code number must be communicated via the network", which decreases the value on the payment card. Thus, although the card is worth a maximum of 40 francs, the user may select a lower monetary amount.

Art Unit: 3621

For example, the payment card of Ittah is worth a max of 40 francs, if a user wants to make a payment, he can select a monetary amount of 3FF (associated value 34547) and 7FF (associated value 435D8) for a total of 10 francs (see fig. 1). Once the amount is selected, the removes the selected portions by starching the associated boxes, which will “enable the selected monetary amount”. The total amount of 10 francs is subtracted form the card’s max value of 40 francs. Further, Ittah clearly expresses the steps of claim 1.

Also, Applicant argues, “...template 4 and the associated numbered boxes disclosed by Hedgcoth having nothing to do with selecting the amount of the financial instrument”. However, whether or not Hedgcoth disclose this feature will not be consider because the primary reference, Ittah clearly teaches this feature (see response above).

Additionally, Applicant argues that Leonard and D’Agostino also fail to disclose a payment card, which can represent any numerical value through the removal of a mask layer. Again, the examiner will not consider this argument because the primary reference, Ittah clearly teaches this feature.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 3621

5. Claims 1-4, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2747962 to Ittah (see Translation of French Patent) in view of US Patent No. 4958066 to Hedgcoth.

Referring to claim 1, Ittah discloses a process for payment of a selected amount by a payer with a payment card, associated with a monetary value, said boxes being covered before use by a masking device which masks a unique code comprising: selecting a monetary amount for the payment card, removing selected portions of the masking device by selecting a number of units in corresponding to the boxes to enable the selected monetary amount; and communicating codes corresponding c to the boxes whose masking device has been removed by the payer to a transaction receiving center (i.e. "information processing center") for monetary payment verification (see pg. 2, lines 4-12; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a multiplicity of series of 10 boxes numbered from 0 to 9. Hedgcoth discloses a multiplicity of series of 10 boxes numbered from 0 to 9 (see fig. 1, reference characters 2 & 11; col. 3, lines 59-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a multiplicity of series of 10 boxes numbered from 0 to 9. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

Referring to claim 2, Ittah discloses the card further comprises a zone having a series of numbered boxes for designation of a number of uncovered payment boxes (see pg. 2, lines 13-14, see Figure1, ref. character (4)).

Art Unit: 3621

Referring to claim 3, Ittah discloses the card has a unique identification number (see pg. 3, lines 8-9, 18-19; pg. 4, lines 1-3).

Referring to claim 4, Ittah discloses the process wherein payment is implemented by communication of codes corresponding to boxes whose masking device were removed by the payer and a personal identification number of the payer (see pg. 3, lines 18-19; pg. 4, lines 1-3).

Referring to claim 7, Ittah discloses a payment card having boxes having a unique code and a mask which hides the unique codes, at least selected portions of the mask corresponding to selected boxes being removable to reveal a unique code corresponding to each box such that when selected portions of the mask are removed by a user to represent a selected numerical payment value, a third party (i.e. "center for information processing"), in possession of corresponding verification codes for the unique codes of the selected boxes, can verify the selected payment value (see pg. 2, lines 6-10; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value. Hedgcoth discloses a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value (see fig. 1, reference characters 2 & 11; col. 3, lines 59-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a support having a multiplicity of series of 10 boxes numbered from 0 to 9. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

Art Unit: 3621

Referring to claim 8, Ittah discloses the payment card further comprising group of boxes corresponding to each of said series of boxes (see fig. 1, (4)).

Referring to claim 9, Ittah discloses a payment card having unique codes (see claim 7 above). Although, Ittah does not explicitly teach three character alphanumeric codes, the examiner notes that the code may be any length (1,2,3...n) without departing from the scope of Ittah's invention.

Referring to claim 11, Ittah discloses a secure payment card comprising a support having unique code; and a mask which hides the codes, at least selected portions of the mask corresponding to selected boxes being removable to reveal a unique code corresponding to each box such that when selected portions of the masks are removed by a user to represent any selected numerical payment value, a third party (i.e. "center for information processing"), in possession of corresponding verification codes for the unique codes of the selected boxes, can verify the selected payment value, a transaction center (i.e. "center for information processing") containing said verification codes which verifies the authenticity and coherence of the selected payment value (see pg. 2, lines 6-10; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of an undefined payment value. Hedgcoth discloses a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value (see fig. 1, reference characters 2 & 11; col. 3, lines 59-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said

Art Unit: 3621

series corresponding to base units and multiples thereof. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

1. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah and Hedgcoth as applied to claim 1 above, and further in view of US Patent No. 4667985 to Leonard et al.

Ittah discloses the payment card having a series of boxes (see claim 1 above). Ittah does not expressly disclose the payment card having a series of boxes for designation of the type of currency of payment, nor the series of boxes corresponding to base units, tens, hundreds, thousands, tens of thousand, tenth and hundredths. Leonard et al. disclose the payment card designating the type of currency of payment and the series of boxes corresponding to base units, tens, hundreds, thousands, tens of thousand, tenth and hundredths (see Abstract, lines 1-5; fig. 1, ref. Character (40)). Note. Leonard et al. disclose these features for a bank check or like instrument; thus, these features can be used for a payment card. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the card disclose by Ittah to include the payment card having a series of boxes for designation of the type of currency of payment, and the series of boxes corresponding to base units, tens, hundreds, thousands, tens of thousand, tenth and hundredths. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

Art Unit: 3621

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah and Hedgcoth as applied to claim 7 above, and further in view of Leonard et al.

Ittah discloses the payment card having a series of boxes (claim 7 above). Ittah does not expressly disclose the payment card having the multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands. Leonard et al. disclose payment card having the multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands (see Abstract, lines 1-5; fig. 1, ref. Character (40)). Note. Leonard et al. disclose these features for a bank check or like instrument; thus, these features can be used for a payment card. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands. One of ordinary skill in the art would have been motivated to do this because it provides a clear presentation to the cardholder.

3. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah and Hedgcoth as applied to claim 11 above, and further in view of US Pub. No. 2002/0120587 to D'Agostino.

Ittah discloses a transaction center containing said verification codes, which verifies the authenticity and coherence of the selected payment value (see pg. 5, lines 3-5). Ittah does not expressly disclose the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment. D'Agostino discloses the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment (see paragraphs [012], lines 10-19; [013], [014]). At the time the invention was made,

Art Unit: 3621

it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Ittah to include the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives a payment for the service provided.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the

Application/Control Number: 10/054,385

Page 10

Art Unit: 3621

organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft .

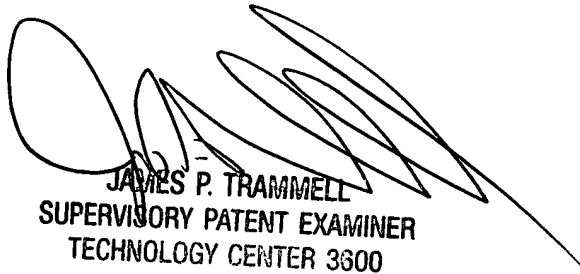
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

November 18, 2003


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**